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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,966	07/25/2003	William G. Dennis	MPD-001.01	3962

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FOLEY HOAG, LLP
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BOSTON, MA 02110

EXAMINER

NGUYEN, TUAN VAN

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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06/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/626,966	Applicant(s) DENNIS, WILLIAM G.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31,32,34-43,45-53,55,56 and 69-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,32,34-43,45-53,55,56 and 69-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 31, 32, 34-43, 45-53, 55, 56, 69, and 70 were pending and they were examined and rejected in previous Office action.
2. This Office action is in response to the RCE filed on April 3, 2009.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 3, 2009 has been entered.

Response to Amendment

4. According to the submission filed on April 3, 2009, claims 71 and 72 are new. Accordingly, claims 31, 32, 34-43, 45-53, 55, 56, and 69-72 are pending in this present application and they are presented for examination.
5. Applicant argues that Shipp fails to disclose new limitation of "wherein the trigger is operably linked to the jaw push tube and to the clip pusher such that the trigger sequentially actuates first the jaw push tube and afterward the clip pusher, so that the applicator adopts a first stage in which the jaw push tube advances and

causes the jaws to engage but the clip pusher does not move, and a second, later, stage in which the clip pusher advances to urge a clip onto the support shelves of the engaged jaws” as required in claims 31 and 42 is incorrect. Shipp discloses (col. 11, lines 45-50) when trigger 16 is squeezed and actuator lever 184 begins to pivot, force is immediately simultaneously applied to begin closing the jaws and to begin pushing the clips and there is a slight delay in the beginning of movement of the clips due to the compression of spring 125. Examiner contends that “**delay**” is equivalent to the limitation of “later” as required in claims 31 and 42. Thus, Shipp discloses when the trigger is actuated by the user, the trigger transfers a continuous force to, first, push the jaw push tube to close the jaw then, second, later the clip pusher is moved distally to move the clips. There is a delay between the steps of closing the jaw and moving the clip even though the steps are dependent on a continuous force.

Drawings

6. Examiner acknowledge Replacement drawing sheet 13/14 in compliance with 37 CFR 1.121(d) is filed with the submission. No new matter is added.

Specification

7. The disclosure is objected to because of the following informalities: paragraph [053], line 8, recites "the jaw assembly 200". Examiner understood that applicant intended to recite "the jaw assembly 260". Appropriate correction is required.

Claim Objection

8. Claim 31 and its dependent claims are objected to of the following informalities:
claim 31, line 8, recites limitation “the support member”. There is insufficient antecedence basis for this limitation in the claim. Appropriate correction is required.
9. Claim 42 and its dependent claims are objected to of the following informalities:
claim 42, line 19, recites limitation “the support member”. There is insufficient antecedence basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 31, 32, 34-43, 45-53, 55, 56, and 69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Shipp et al. (U.S. 6,350,269).**
12. Referring to claim 31, Shipp discloses (see Figs. 1-9 and 13-34) an occlusion clip applicator 10 for storing and applying a plurality of occlusion clips 64 (see Fig. 9), the applicator comprising:

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- a. a jaw push tube 18 having proximal and distal push tube ends and a jaw push tube interior;
- b. an elongate clip holder 58 (see Figs. 13-18 and col. 6, lines 49-63) configured to hold the plurality of occlusion clips, the clip holder being formed as a channel having first and second support rails 61 and 63 attached thereto, the first and second support rails being substantially parallel and in alignment with each other and defining a gap with a gap width dimension that is greater than the main body width of the occlusion clips 64 and less than the maximum arcuate width 72 (see Fig. 9) of the occlusion clips, the clip holder having proximal and distal clip holder ends and being disposed inside the jaw push tube interior;
- c. a clip pusher 102 (see Figs. 25-28 and see col. 9, lines 23-55) having an elongate support member having upper and lower sides with a plurality of clip push prong 104 or fingers 104 attached to the lower side wherein the finger 104 configured to engage the upper arcuate portions 72, 74 of the occlusion clips 64 so that distal movement of the clip pusher causes the occlusion clips to slide distally along the support rails 61, 63, the support member 102 being mounted within the jaw push tube interior substantially parallel to the clip holder 58 with at least a portion of each clip push finger extending downward into the channel;
- d. a pair of jaws 20, 22, (see Fig. 19-24 and see col. 6, lines 37-49) each jaw having proximal and distal jaw ends, an inner engaging side and an

opposite outer side, a clip slot 94 formed through the jaw from the inner engaging side to the outer side and extending distally from and through the proximal jaw end, and a pair of parallel support shelves 214, 216 bounding at least a portion of the clip slot, the jaws being pivotably mounted at their proximal ends 97 to the distal clip holder end 99 (see Figs. 18 and 19) and being configured for engagement by the distal tube end at 109, 111 for selective rotation between a fully open position and a closed position wherein the engaging sides of the jaws are in contact with each other, wherein the clip slot has a width dimension that is greater than the main body width of the occlusion clips and less than the maximum arcuate width of the occlusion clips; an releasing opening 96, 98 or ejection opening at the distal jaw end, wherein the ejection opening having a width that is greater than the maximum arcuate 72 of the occlusion clip 64;

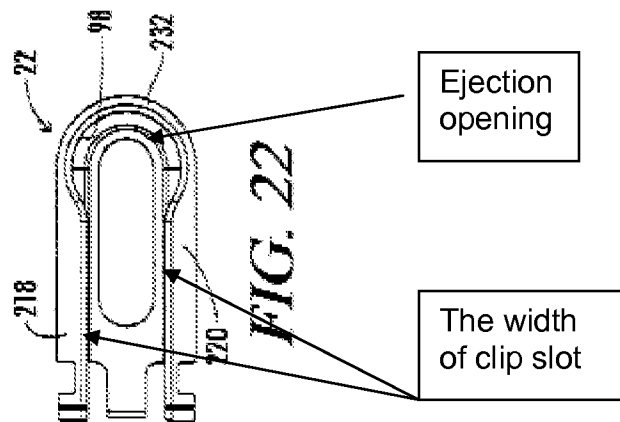
- e. a trigger 16 associated or connected to actuator assembly, which includes actuator lever 184, primary outer tube piston 164, push rod piston 114 and intermediate outer tube 38. The trigger actuates the actuator assembly to actuate jaw push tube 18 to actuate the jaw 20, 22 open or close and moving clip pusher 102 to move a clip into the jaw 20, 22 (see col. 11, line 14 to col. 12, line 15). In column 11, lines 45-50 Shipp discloses when trigger 16 is squeezed and actuator lever 184 begins to pivot, force is immediately simultaneously applied to begin closing the jaws and to begin

pushing the clips and there is a slight delay in the beginning of movement of the clips due to the compression of spring 125. Examiner contends that “**delay**” is equivalent to the limitation of “later” as required in claims 31 and 42.

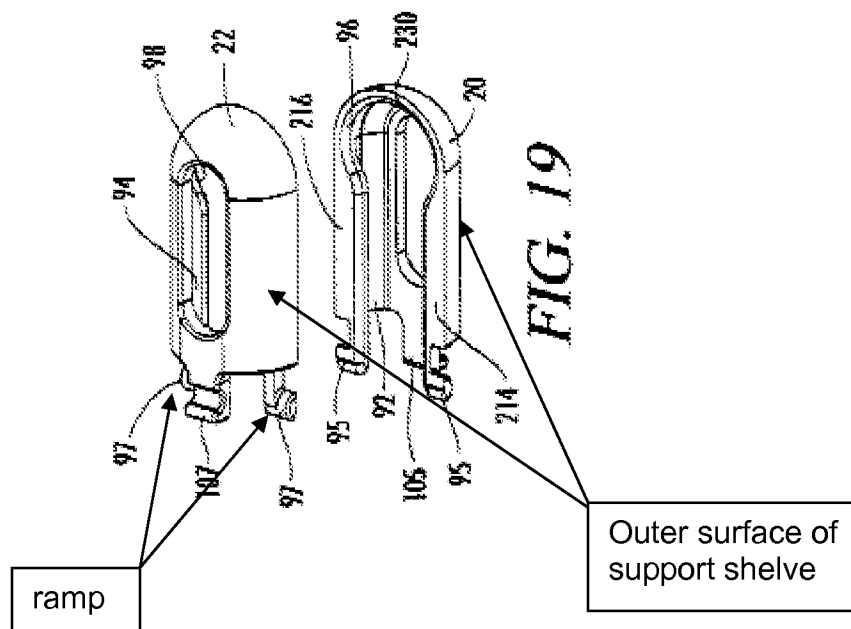
- f. a handle assembly 12 and 16 include a barrel rotator 14 or a tube housing defining a bore 24 or a tube chamber (see col. 9, lines 57-60), the proximal push tube end of tube 18, the proximal clip holder end of clip holder 58 and at least a portion of the actuator assembly, which includes actuator lever 184, primary outer tube piston 164, push rod piston 114 and intermediate outer tube 38, to actuate jaw push tube 18 to actuate the jaw 20, 22 open or close and moving a clip into the jaw 20, 22 being disposed in the tube chamber (see col. 11, line 14 to col. 12, line 15).
- 13. Referring to **claims 34 and 55**, see item (b) in paragraph 9 above.
 - 14. Referring to **claims 35, 45 and 56**, see item (c) in paragraph 9 above.
 - 15. Referring to **claims 36-38, 40, 48 and 50**, Examiner understood that applicant intended to invoke 35 USC § 112, sixth paragraph. Shipp discloses (Figs.1-5 and 29-32) a trigger 16 associated or connected to actuator assembly, which includes actuator lever 184, primary outer tube piston 164, push rod piston 114 and intermediate outer tube 38. The trigger actuates the actuator assembly to actuate jaw push tube 18 to actuate the jaw 20, 22 open or close and moving clip pusher 102 to move a clip into the jaw 20, 22 (see col. 11, line 14 to col. 12, line 15).

16. Referring to **claims 39 and 49**, in column 11, lines 45-50 Shipp discloses when trigger 16 is squeezed and actuator lever 184 begins to pivot, force is immediately simultaneously applied to begin closing the jaws and to begin pushing the clips and there is a slight delay in the beginning of movement of the clips due to the compression of spring 125. Thus, Shipp discloses the distal movement of the jaw push tube 18 and the clip pusher 102 happened in sequence initiated by a user via squeezing of the trigger 16.
17. Referring to **claims 41 and 51**, see item (f) in paragraph 9 above.
18. Referring to **claim 42**, with respect to the preamble, it has been carefully considered but deemed not to impose any structural limitation on the claims distinguishable over the applicator as disclosed by Shipp which is capable of being used to delivering the clip as recited in the preamble. Figures 8-12 of Shipp's drawings disclosed the clip that claimed in the preamble of claim 42. Further, in US Pub. No. 2006/0129168, Shipp discloses such a clip as claimed in the preamble of claim 42 (see Fig. 1), furthermore, Shipp discloses the clip can be deployed by a clip applicator as discloses in US Patent No. 6,350,269 issued to Shipp (see paragraph [0043]).
19. Referring to **claims 32 and 53**, Figure 22 (reproduced below) shows the jaw has a clip slot terminates in an ejection opening 98 adjacent the distal jaw end 232, the clip slot having a slot width and the ejection opening having an ejection opening width that is greater than the slot width.

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20. Referring to **claims 71 and 72**, Figs. 19 and 21 of Shipp's drawings show the elements 95 and 97 are not continuous with the outer surfaces of the respective support shelves has been fully considered but they are not persuasive. Figures 19 and 22 of Shipp's drawings show a pair of ramp, which includes elements 95 connected with first jaw side 214 and 216 (see Fig. 19), and elements 97 connected with second jaw side 218 and 220 (see Fig. 20), wherein the ramps having outer surfaces that aligned with the respective support rails 61 and 63 of the clip holder 58 (see Fig. 16) and are continuous with the outer surfaces of the respective support shelves (see Figs. 19 and 22 reproduced below this paragraph).



Conclusion

This Office action could be made Final even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114 (see MPEP § 706.07(b)) because all claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. However, Examiner believes that applicant has shown earnest effort to further define the claimed invention to expedite the prosecution of the present application, therefore, this Office action is not made Final.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan V Nguyen/
Examiner, Art Unit 3731